IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.	:	10/637,608
Appellants/Applicants	:	FLYNN, *ET AL.*
Filed	:	AUGUST 11, 2003
Title	:	HYDROGEN ODORANTS AND ODORANT SELECTION METHOD
Art Unit	:	1754
Examiner	:	LANGEL, WAYNE A.
Atty. Docket No.	:	ENER-0001-UT1

Mail Stop Appeal Brief - Patents
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EXAMINER INTERVIEW SUMMARY UNDER 37 C.F.R. § 1.133

Appellants wish to thank Examiner Langel for the courtesies extended to Appellants' counsel during a Telephone Interview on March 12, 2008 (Examiner Interview).

During the Examiner Interview, Appellants' counsel discussed the Examiner's Answer March 10, 2008 (Examiner's Answer) and the Examiner's ***failure throughout the prosecution of the present application, including in the Examiner's Answer, to identify a single non-sulfur compound in the reference French Patent 2,645,622 ("FR '622")***, despite the Examiner making such allegations as the following in the Examiner's Answer:

Allegation 1

> FR '622 discloses in the English Abstract that an odorous gaseous product is added, "such as a mercaptan, a thiophane, or a product known under the name "TBM". Since the reference uses the phrase "such as" as mercaptan . . . , it is clear the reference contemplates other odorous gaseous products, which would include the selenium compounds recited in appellants' claims.[1]

[1] *See* Examiner's Answer, paragraph bridging pp.6- 7.

Allegation 2

> . . . FR '622 is not limited to the use of sulfur compounds, in view of the phrase "such as" in the English Abstract.[2]

As pointed out by Appellants' counsel during the Examiner Interview, although Appellants' have repeatedly requested the Examiner to cite the portions of FR '622 that the Examiner is relying on to reject the claimed invention[3], to date, the Examiner has yet to cite a single portion of FR '622 that supports the Examiner's allegations about FR '622, including Allegations 1 and 2 above. In rejecting the claimed invention over FR '622, the Examiner has only cited to and relied on the English Abstract, not FR '622 which is a French language document.

Appellants' counsel also pointed out that the Examiner has so far failed to comply with the requirements of requirements of M.P.E.P. § 706.02(II) which states:

M.P.E.P. § 706.02(II)

> Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. ***Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See Ex parte Jones, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).***
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> To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. ***If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.*** The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. ***The converse may also be true, that the full text document will include teachings away from the invention that will***

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[2] *See* Examiner's Answer, p. 7, first full paragraph.

[3] *See* for example: Appellants' January 21, 2005 Amendment, paragraph bridging pp. 7-8; Appellants' June 23, 2005 Appeal Brief, Argument, Section A(4), p. 9; Appellants' October 2005 Amendment, Section A(2)(a), pp. 10-12 and Section B(1)(a) pp. 14; Appellants' January 12, 2006 Request for Pre-Appeal Brief Review, Sections A, B and C, pp. 1-2; and Appellants' September 25, 2006 Appeal Brief, Section VII(A)(7), p. 12.

preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.[4]

Appellants counsel noted that because FR '622 is a foreign language document, under M.P.E.P. § 706.02(II) the Examiner must provide an English language translation of FR '622 and must cite to and rely on FR '622, not an English Abstract of FR '622, when the Examiner rejects Claims 2-4, 7-11, 47-53 and 59 over FR '622.

Based on the Examiner Interview, the Examiner stated that he would provide Appellants with an English translation of FR '622 and discuss with his supervisor the possibility of re-opening prosecution of the present application to provide rejections based on an English translation of FR '622 and not based merely on the English Abstract of FR '622.

Appellants' counsel requested that if the Examiner re-opens prosecution to either: (1) provide new rejections based on an English translation of FR '622 and to identify specific non-sulfur compounds taught and/or suggested in the English translation of FR '622 or (2) withdraw the rejections relying on FR '622[5] and allow all of the pending claims.

Appellants' counsel also indicated that they would not file a Reply Brief in response to the Examiner's Answer until the Examiner has determined whether the Examiner will be re-opening prosecution of this application.

Should the Examiner feel that there are any issues outstanding in light of the Examiner Interview, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

Respectfully submitted,

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[4] *See* M.P.E.P. § 706.02(II), emphasis added.
[5] All of the currently pending rejections.